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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/272,562	03/19/99	ALAM S	MDHS-378A

IM22/0802

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EXAMINER	
GUARRIELLO, J	
ART UNIT	**PAPER NUMBER**
1771	3

DATE MAILED: 08/02/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
09/272,562	Alam et al.
Examiner	**Group Art Unit**
John Guarriello	2771

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Peri d for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle,* 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

☑ Claim(s) 1-15 is/are pending in the application.

Of the above claim(s) 12-15 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☑ Claim(s) 1-11 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 11 9(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

*Certified copies not received: _____.

Attachment(s)

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☑ Notice of Reference(s) Cit d, PTO-892

☑ Notice of Draftsperson's Patent Drawing R vi w, PTO-948

☐ Int rview Summary, PTO-413

☐ Notice of Informal Patent Application, PTO-152

☐ Other _____

Office Action Summary

DETAILED ACTION

15. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-11, drawn to screen ink printed film carrier, classified in class 442, subclass 228.

II. Claims 12-15, drawn to electrically modulated device, classified in class 428, subclass 195.

16. The inventions are distinct, each from the other because:

Inventions I and II are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful as a decorative overlay upon a laminated article and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

17. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

18. During a telephone conversation with Ramon Hoch on 5/16/2000 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-11. Affirmation of this election must be made by applicant in replying to this Office action. Claims 12-15 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

19. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

20. The preliminary amendment cancelling claims 16-20 has been entered and is acknowledged.

21. The use of the trademark "FM-300", on page 6, line 25 has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

22. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 8-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Callahan 5,364,705.

Callahan teaches a resistive sheet with an electrically conductive ink layer and an electrically resistive ink layer on a substrate or a part of the sheet, (see abstract). Callahan teaches that the substrate can be polyester and can be cured, (column 2, lines 9-29; lines 60-65; column 5, lines 20-36). Callahan teaches the ink pattern can be polygons which can be changed in size, (column 3, lines 49-55). Conductive ink and magnetic particles are known. Callahan teaches the essential limitations of the claimed invention. Claims lack novelty.

23. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Williams et al. 4,321,404.

Williams teaches coating compositions which can be used in providing substrates with a strongly adhering abhesive coating. Such substrates can be metal , plastics like polyester and

others, (column 13, lines 38-45). Abhesive coatings can carry an image, like an ink pattern, (column 14, lines 5-8). Williams teaches the abhesive coated substrate can be imaged with a fused xerographic design, (column 13, lines 67-68; column 14, line 1).

Williams teaches the essential limitations of the claimed invention. Claim 1 lacks novelty.

24. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,2 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Kawai et al. 5,403,422.

Kawai teaches a base sheet, which is similar to the screen ink printed film carrier, impregnated with a thermosetting resin which base sheet can be woven or nonwoven synthetic resin fiber, which is similar to the fibrous sublayer or textile layer, (column 4, lines 44-50). Kawai teaches that a pattern layer, which is similar to the continuous surface layer of resin with ink, can be formed in a known printing manner using conventional ink, (column 3, lines 30-34). Kawai teaches the ink composition can be used for forming the pattern layer, which is similar to the continuous layer, (column 4, lines 28-30). Kawai teaches the essential limitations of the claimed invention. Claims lack novelty.

25. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 3, 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawai et al. 5,403,422 in view of Pittman et al. 5,102,727.

Kawai as above in paragraph # 24 except Kawai differs from the claimed invention because it is silent about scrims, and the thickness of the fabric.

Pittman teaches electrically conductive textile fabric, which is woven or nonwoven and is similar to scrims (which are woven fabrics), (column 2, lines 14-51). Pittman teaches that the amount of woven and knitted fabrics can be varied as in thickness, (see abstract).

It would have been obvious to one of ordinary skill in the art at the time the invention was made in view of the teachings of Pittman regarding woven and nonwoven fabrics , which are similar to scrims, and the varying the thickness aspects of the fabric, to modify Kawai regarding the woven and nonwoven fabrics which are similar to scrims and the varying thickness aspects of Pittman motivated with the expectation that the screen ink printed film carrier would be improved regarding properties of flexibility as applied to surfaces of different substrates.

26. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

27. Claims 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawai et al. 5,403,422 in view of Ruffoni 5,185,381 and Whyzmuzis 5,714,526.

Kawai as above in paragraph # 24 except Kawai differs from the claimed invention because it is silent about the components of the ink pattern and the hexagonal shaped printing pattern.

Ruffoni teaches a resin carrier with ink which is conductive with silver, copper, nickel and others, (see abstract).

Whyzmuzis teaches pigments for ink with ferrite yellow oxide, red iron oxides, ferric iron oxide brown and others, (column 6, lines 37-55).

It would have been obvious to one of ordinary skill in the art at the time the invention was made in view of the teachings of Ruffoni regarding conductive materials for ink and Whyzmuzis with pigments of ferrite and iron for ink to modify Kawai regarding the conductive materials for ink of Ruffoni and the pigments of ferrite and iron for ink of Whyzmuzis motivated with the expectation there would be an improved screen ink printed film carrier with sharper definition of the printing pattern on a substrate. Regarding the hexagonal printing pattern, this would be a mere matter of rearranging the printing pattern and would be routine in the printing art, In re Japikse, 86 USPQ 70.

28. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Guarriello whose telephone number is (703) 308-3209. The examiner can normally be reached on Monday to Friday from 8 am to 4 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris , can be reached on (703) 308-2414. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-5408.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

John J. Guarriello:gj

Patent Examiner

June 19, 2000

July 6, 2000

July 31, 2000

BLAINE COPENHEAVER
PRIMARY EXAMINER